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CENTRAL FAX CENTER****JUL 09 2005****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Applicant: Safko	)	Art Unit: 2154
	)	
Serial No.: 09/665,368	)	Examiner: Chang
	)	
Filed: September 19, 2000	)	1173.001
	)	
For: <u>SYSTEM AND METHOD FOR PROVIDING PAPER</u>	)	July 9, 2005
<u>MODELS OVER A WIDE AREA COMPUTER</u>	)	750 B STREET, Suite 3120
<u>NETWORK</u>	)	San Diego, CA 92101
	)	

**RESPONSE TO OFFICE ACTION**

Commissioner of Patents and Trademarks  
Washington, DC 20231

Dear Sir:

In response to the Office Action dated May 9, 2005, and at the request of Mr. Follansbee, SPE, to further explicate on the sufficiency of the previous declaration swearing behind Kitty Hawk, herewith are Applicant's comments. The SPE indicated a desire to review Applicant's comments with other PTO personnel; accordingly, it is expected that the examiner will pass this paper along to the SPE for review.

**Procedural Error**

The sole reason for the refusal to accord the declaration weight is that "the evidence does not meet the standard of enablement", without any further explanation as to why. This is the first defect in the rejection, see MPEP §2164.04 ("an examiner must provide a reasonable explanation" as to lack of enablement; lack of enablement cannot be alleged "unless there is an objective reason to doubt" it). While

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MPEP §2164.04 is directed to the enablement of a patent specification, plainly the same issues and principles are in play when an examiner refuses to accord evidence of prior invention any weight due to alleged lack of enablement. Here, no explanation as to why, precisely, the examiner believes that the evidence supporting the declaration would be insufficient to enable one skilled in the art to make and use the invention. Only the ultimate legal conclusion, unsupported by findings of fact based on evidence of record, has been made.

### Substantive Error

The substantive error is perhaps even more interesting. Put simply, the relied-upon Kitty Hawk Web page is certainly no more detailed, and arguably is less detailed, than the evidence supporting the declaration. If the evidence is not enabling, then neither is Kitty Hawk, removing it as reference. If Kitty Hawk is enabling, then so is the evidence supporting the declaration - removing Kitty Hawk as a reference. The result is the same either way.

With more specificity, consider that the first page of Kitty Hawk teaches merely that a software kit for making Origami flowers is available, and it also lists a few other kits. Apart from mostly promotional verbiage, about all that appears on the first page is folding information. The second page simply discusses two commercial computer systems that the software can be used with. The third and fourth pages are links that can be clicked to download limited versions of the software kits. No further discussion exists related to how the kits are rendered into files, posted on the Web, or other technically enabling information. The last three pages of Kitty Hawk alert the user that the download process is secure, and these pages also provide the nature of the required financial information. And that's all.

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Apart from the general lack of any sort of technically enabling information in Kitty Hawk, Applicant notes that nothing in it mentions using 3D stereoscopic photography as set forth in Claim 20. Simply pointing to three dimensional models, as the rejection does, is wholly insufficient to show that prior to the present invention the 3D models of Kitty Hawk were anything other than hand drawn; certainly, a particular type of 3D photography appears nowhere in Kitty Hawk.

Turning to the evidence supporting the previous declaration for comparison with Kitty Hawk, consider that page "4 of 27", in addition to mentioning several different types of models that can be "downloaded from the Internet", teaches several technical details omitted by Kitty Hawk, including that the 3D models are "photo-realistic". Unlike Kitty Hawk, which nowhere teaches the skilled artisan how its kits are made, page "12 of 27" of the evidence explicitly teaches that digital photographs can be used, and that these may be transformed into 2D shapes in one of many computer file formats. The files are further taught to be hardware independent. The point is that the evidence is much more detailed in explaining how the model files are generated than is Kitty Hawk. Not only that, but owing to the detailed nature of the evidence it remains most unclear just why the examiner believes it would not enable the skilled artisan to render model files and post them for downloading on the Internet. Perhaps that is why he did not give any reasons. In any case, any reason given for an alleged lack of enablement of the evidence perforce damns Kitty Hawk as a reference, for reasons discussed above.

The May 1999 version of Kitty Hawk, mentioned briefly in the last Office Action, has not been relied on and in any case is noteworthy for its complete lack of discussion of downloading files. It appears that in the May 1999 version the only thing a user can do using the Internet is to submit an order for a kit.

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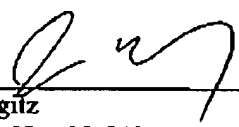
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The examiner is authorized to correct the dependencies on Claim 10 to Claim 9 by examiner's amendment.

Respectfully submitted,

  
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